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09/965,405	09/26/2001	Tami L. Guy	10013329-1	3798
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EXAMINER				
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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* TAMI L. GUY, JEFFREY L. BRIGGS, and ANNE L. MASON
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11 Appeal 2009-007254
12 Application 09/965,405
13 Technology Center 3700
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16 Decided: February 25, 2010
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20 *Before:* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and BIBHU R.
21 MOHANTY, *Administrative Patent Judges.*

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23 CRAWFORD, *Administrative Patent Judge.*
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26 DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection of claims 1 to 13, 15, 17, and 18. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented a method of doing business (Spec. 1).

Claim 1 under appeal reads as follows:

1. A method for a first organization to do business comprising:
entering into a contractual relationship with a second organization;
authorizing said second organization to take an order from a customer, said order comprising at least one of:
products not produced by said first organization, and services not provided by said first organization;
receiving payment directly from said customer as a payment for said order taken by said second organization;
requiring an organization other than said first organization to ship products not produced by said first organization to said customer;
requiring an organization other than said first organization to provide services to said customer.

The Examiner rejected claims 1 to 6 and 8 to 12 under 35 U.S.C. § 103(a) as being unpatentable over Sharp in view of Curie.

The Examiner rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Sharp in view of Curie and Hogan.

The Examiner rejected claims 13 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Sharp in view of Carpenter.

The Examiner rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Sharp in view of Work.

The Examiner rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Sharp in view of Bremers.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Hogan	US 2001/0002464 A1	May 31, 2001
Work	US 2002/0007302 A1	Jan. 17, 2002
Carpenter	US 6,868,401 B1	Mar. 15, 2005
Bremers	US 6,901,380 B1	May 31, 2005

ISSUE

Do claims 1 to 13, 15, 17, and 18 recite patentable subject matter in accordance with 35 U.S.C. § 101?

FINDINGS OF FACT

Claims 1 to 7, 9, 11, 13, 15, 17 and 18 recite a series of steps involving entering into a contractual relationship for products and services between a first and second organization. These claims do not recite a machine or any step that transforms an article.

Claims 8, 10, and 12 depend on claims 1 or 11 and include the step of tracking receipt of payment by a computer.

PRINCIPLES OF LAW

Section 101 of the Title 35 of the United States Code states:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement

thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

An applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article into a different state of thing. *In re Bilski*, 545 F.3d 943, 961 (Fed. Cir. 2008), *cert. granted*, 129 S. Ct. 2735 (2009); *see also Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). The use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. *Bilski*, 545 F.3d at 961-62 (*citing Benson*, 409 U.S. at 71-72).

ANALYSIS

New rejection under 35 U.S.C. § 101

Pursuant to 37 C.F.R. § 41.50(b) (2009) we enter a new rejection of claims 1 to 13, 15, 17, and 18 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

Claims 1 to 7, 9 to 11, 13, 15, and 17 recite steps that are not tied to a particular machine and do not transform an article to a different state and therefore are not patentable subject matter.

Claims 8, 12, and 18 recite in various forms the step of tracking receipt of payment by a computer. This recitation of a computer is not a recitation of a *particular* machine but rather is a recitation of no more than a general purpose computer programmed in an unspecified manner to implement the tracking step. In addition, the recitation of a computer does not impose meaningful limits on the claims' scope.

1 Prior art rejections

2 Claims 1 to 13, 15, 17, and 18 are rejected under 35 U.S.C. §§ 102
3 and 103 as detailed above. As to these prior art rejections, our decision is
4 dispositive with respect to patentability since the claims do not recite patent-
5 eligible subject matter under § 101. We therefore do not reach the questions
6 of whether the claims would have been anticipated under § 102 or obvious
7 under § 103. *See Diamond v. Diehr*, 450 U.S. 175, 188 (1981); *In re*
8 *Comiskey*, 554 F.3d 967, 973 (Fed. Cir. 2009) (declining to reach
9 obviousness rejection on appeal after concluding many claims were
10 nonstatutory under § 101); *Bilski*, 545 F.3d at 950-51 n.1 (noting that § 101
11 is a threshold requirement and that the Examiner may reject claims solely on
12 that basis); *In re Rice*, 132 F.2d 140, 141 (CCPA 1942) (finding it
13 unnecessary to reach rejection based on prior art after concluding claims
14 were directed to nonstatutory subject matter).

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16 CONCLUSION OF LAW/DECISION

17 We do not reach the prior art rejections of the appealed claims.

18 We have entered a new rejection of all the pending claims under 35
19 U.S.C. § 101.

20 This decision contains a new ground of rejection pursuant to 37
21 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960
22 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37
23 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this
24 paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the appellant elect to prosecute further before the examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with
this appeal may be extended under 37 C.F.R. § 1.136(a) (2007).

37 C.F.R. § 41.50(b)

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